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REMARKS

Claims 1-25 are currently pending in the subject application and are presently under consideration. Claims 1-22 have been amended herein to correct minor informalities. In addition, claim 24 stands cancelled. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-24 Under 35 U.S.C. §103

Claims 1-24 stand rejected under 35 U.S.C. §103 as being unpatentable over Metheny *et al.* (US 5,763,969). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Metheny *et al.* fails to teach or suggest all limitations recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added).

The subject invention relates to a machine diagnostic system for on-line diagnosis of machine characteristics that contains packaging to dissipate heat. In particular, amended independent claim 1 (and similarly in independent claim 23) recites a machine diagnostic system comprising a machine diagnostic module which collects data relating to operation of the machine and a package which is permanently mounted to an outer mounting surface of the machine, so that the *machine diagnostic module recovers data*

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from a same precise location on the outer mounting surface and comparison reliability of data collected at appropriate times is substantially increased. Metheny *et al.* does not teach or suggest each and every element of the invention as claimed.

Metheny *et al.* relates to an integrated motor control system that includes an electric motor, a fan that generates cooling air flow as the motor rotates and a motor drive connected to the electric motor frame. (See Abstract). The control system as recited in Metheny *et al.* operates through an operator interface, (see col. 4, ln. 24-39), and does not employ feedback control suggestive of machine diagnostics. Since Metheny *et al.* does not employ machine diagnostics, it is further silent with regard to a precise location on the outer mounting surface, data collection, permanent mounting, and reliability comparison of data. As such, the Examiner concedes that Metheny *et al.* does not disclose an integrated diagnostic module within the controller. (See Office Action dated April 18, 2005, pg. 2).

The Examiner attempts to compensate for the aforementioned deficiencies of Metheny *et al.* by referencing page two of the instant specification and notes that it is well known to monitor machines in general and rotating machines and their related controllers in particular for their operating state. (See Office Action dated 4-18-05, pg. 2). However, nowhere is it taught or suggested by Metheny *et al.* nor is it conceded in the instant specification as being well known that a machine diagnostic module can recover data *from the same precise location on the outer mounting surface*, as in the claimed invention. Moreover, the claimed feature of *comparison reliability of data collected at appropriate times is substantially increased* is novel in view of the admitted prior art and Metheny *et al.* As such, it seems that the Examiner is failing to provide such claim limitations patentable weight. Thus, Metheny *et al.* fails to teach each and every aspect of the invention as claimed. Consequently, this rejection should be withdrawn.

The Board of Patent Appeals has rejected a similar argument set forth by the Examiner in previous prosecution of the subject invention. The Examiner contends that because it is known to monitor the operation of a rotating machine, and because it is known that dynamoelectric machines generate heat which is harmful to electronics, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate known monitoring electronics within the monitored dynamoelectric

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machine controller of Metheny *et al.* so as to receive the expected benefits derived therefrom. (See Office Action dated 4-18-05, pg. 2). The Examiner applies *In re* Larson in making this contention. Applicant's representative respectfully disagrees with such a contention. The Examiner's use of hindsight in applying *In re* Larson in previous patent prosecution of the subject invention has been rejected by the Board of Patent Appeals. (See Appeal No. 2004-2306). With regard to Appeal No. 2004-2306, in reversing the rejections to claims 1-25 the Board stated that use of the combination of cited references stemmed from hindsight impermissibly derived from the appellants' disclosure. (See pg. 5). In essence, the rejection was based on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide the advantages as stated in applicant's specification. This type of rationale has been condemned by the CAFC. (See for example, *Panduit Corp. v. Dennison Manufacturing Co.*, 1USPQ2d 1593 (Fed. Cir. 1987).

The current rejection of independent claims 1 and 23 appears similar to the previous rejection. In the previous rejection, the Examiner cited Hays *et al.* and Wang *et al.*, which disclosed diagnostic systems for industrial machines but were silent with regard to recovering data from a same precise location on the outer mounting surface and comparison reliability of data collected at appropriate times is substantially increased, as in the claimed invention. (See Appeal No. 2004-2306 pg. 3). In the current rejection, the Examiner's cited art, namely Metheny *et al.*, also fails to disclose these claimed features, and additionally *does not relate to machine diagnostic systems at all*. Thus, by merely noting that monitoring a machine is well known, and considering that the cited reference *nowhere* discloses a machine diagnostic module, much less that a *machine diagnostic module recovers data from same precise location on the outer mounting surface and comparison reliability of data collected at appropriate times is substantially increased*, the Examiner is again impermissibly applying hindsight knowledge of the benefits recited by the invention as claimed. As a result, the Examiner is again improperly applying *In Re* Larson in the rejection of independent claims 1 and 23. Accordingly, this rejection should be withdrawn.

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As Metheny, *et al.* does not disclose each and every aspect as claimed, it is readily apparent that the rejection of independent claims 1 and 23 (and claims 2-22 and 24 which respectively depend therefrom) should be withdrawn.

II. Rejection of Claim 25 Under 35 U.S.C. §103

Claim 25 stands rejected under 35 U.S.C. §103 as being unpatentable over Metheny *et al.* (U.S. 5,763,969) as applied to claim above, and further in view of Hays *et al.* (U.S. 6,260,004) and Wang *et al.* (U.S. 5,566,092). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Hays *et al.* and Wang *et al.* do not make up for the aforementioned deficiencies of Metheny *et al.* with respect to independent claim 1 (from which claim 25 depends). Therefore, the subject invention as recited in claim 25 is not obvious over the combination of Metheny *et al.*, Hays *et al.*, and Wang *et al.* Thus, it is respectfully requested that this rejection be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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